

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

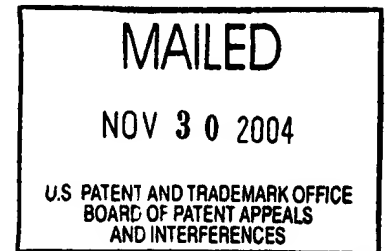
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES R. SIMMERS

Appeal No. 2005-0130¹
Application No. 09/721,790

ON BRIEF



Before HAIRSTON, BARRETT, and LEVY, Administrative Patent Judges
LEVY, Administrative Patent Judge.

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DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-32, which are all of the claims pending in this application.

BACKGROUND

Appellant's invention relates to a split and dual-screen panels in cellular phones. An understanding of the invention can

¹ Reissue application, based on U.S. Patent No. 5,841,431, filed November 15, 1996.

be derived from a reading of exemplary claim 1, which is reproduced as follows:

1. In an information device having a CPU, display controller and a display panel, said display panel split logically into sub-panels, an apparatus comprising:

a plurality of segment drivers coupled between said display panel and said display controller, said segment drivers receiving input data from said controller, said segment drivers translating said data into pixels displayable on said display panel; and

a power control block coupled to said CPU and to said segment drivers to disable a first power source which powers down a first set of said segment drivers, said powering down disabling a first set of sub-panels of said display panel from outputting pixels, said power control block disabling said first power source upon receiving a command from said CPU that said first set of sub-panels are to be powered down, said information device functioning as one of a cellular communications device and a personal digital assistant, said first set of sub-panels displaying information relevant to said personal digital assistant function, further wherein said display panel includes a second set of sub-panels displaying information relevant to said cellular communications functions.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Britz	5,414,444	May 9, 1995
Nomura et al. (Nomura)	5,881,299	Mar. 9, 1999 (filed Sep. 26, 1996)
Imai et al. (Imai)	Des. 377,341	Jan. 14, 1997 (filed Feb. 15, 1996)
Microsoft Press, Computer Dictionary, Second Edition, "PDA," (1994), pp.296		

Claims 1, 5, 7-9, 12-22 and 24-32 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Nomura.

Claims 2-4, 6, 10, 11 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nomura in view of Britz and Imai.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 14, mailed June 30, 2004) for the examiner's complete reasoning in support of the rejections, and to appellant's brief (Paper No. 13, filed August 27, 2003) for appellant's arguments thereagainst. Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered.

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellant's arguments set forth in the

brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer. Upon consideration of the record before us, we affirm, essentially for the reasons set forth by the examiner.

We note at the outset that appellant asserts (brief, page 6) that the claims rejected under 35 U.S.C. § 102(e) stand or fall as a single group, and that the claims rejected under 35 U.S.C. § 103(a) stand or fall as a single group. Accordingly, we select claim 1 as representative of group 1, and select claim 2 as representative of Group 2. We begin with claim 1.

To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). As stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting Hansgird v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939))

(internal citations omitted):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

Thus, a prior art reference may anticipate when the claim limitation or limitations not expressly found in that reference are nonetheless inherent in it. See In re Oelrich, 666 F.2d at 581, 212 USPQ at 326; Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 630, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates. See In re King, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986).

From our review of the entire record, the issue before us depends on whether Nomura teaches, explicitly or inherently, a personal digital assistant (PDA). It is clear from the assertion of appellant and the examiner, as well as our review of Nomura, that Nomura does not provide any explicit disclosure of a PDA. Thus, the issue becomes whether Nomura inherently discloses a PDA. The examiner relies upon a definition of a PDA from Microsoft Computer Dictionary in support of his position that the information device of Nomura includes a PDA. The examiner asserts (answer, page 4) that **"figure 1 item 12, figure 4 items area 1 and area 2, column 5 lines 20-25 and 63-64"** is a disclosure of a PDA. The examiner argues (answer, page 12) that:

based on the definition of PDA absent from the

Appellants specification but provided by Microsoft Press Computer Dictionary (1994), page 296.

PDA - computer designed to provide specific functions such as personal organization as well as communication. Current PDA devices rely on a pen for input instead of a keyboard or mouse.

Nomura teaches of a device with a CPU, figure 1 item 10, therefore it meets the computer limitation.

Nomura teaches of a device with a personal organization function, column 5 line 63-64, figure 4 item area2 [sic], said telephone book feature, and therefore meets the personal organization limitation. Nomura teaches of a phone function and antenna, figure 1 item 28 and figure 3 item 29, therefore it meets the communication limitation.

Nomura teaches of a pen input means, column 5 lines 20-25, and therefore it meets the known PDA input means limitation. Therefore the device taught by Nomura meets every known limitation of a PDA as defined in the art.

Appellant does not dispute the Microsoft definition of a PDA, and make no assertion or argument that an artisan would have understood a PDA to be defined differently from the way a PDA is defined in the Microsoft Dictionary. In fact, we find no reference to the Microsoft Dictionary definition of "PDA" in appellant's brief. Terms in claims are given their general meaning as they would be understood by an artisan, unless appellant indicates that a different definition is to apply.

From our review of appellant's specification, we find that the specification recites (page 2) "[i]n high-end 'smart' cellular phones, which function both for telecommunications and

for storing and retrieving information (e.g., a Personal Digital Assistant (information device)), " and that (page 6) "LCD panel 100 may be used on a notebook computer, a personal digital assistant (PDA), cellular phone or for use in any information device capable of utilizing an LCD output." The specification further discloses (page 13) that "[t]he information device is capable of functioning both as a cellular phone for telecommunications and as a PDA."

From these disclosures in appellant's specification, we find that a PDA is disclosed to be an information device. We find that a PDA as disclosed in appellant's specification, i.e., an information device, to be consistent with the definition of a PDA as defined in the Microsoft Dictionary.

From the disclosure of Nomura, we find that Nomura is directed to an information device (col. 1, line 7). We observe that "information device" is the same phrase used in appellant's specification to describe a PDA. Nomura further discloses that the information device has a plurality of display areas (col. 1, lines 55 and 56). Nomura further discloses that figure 4 is "a view showing one example of information displayed on display panel of FIG. 1". PHS functioning portion 28 is used to carry out radio communications between the information device and a base station (col. 4, lines 47-52). Antenna 29 is used for realizing the PHS function (col. 5, lines 13-15). As disclosed

in figure 3, a key set 31 is used for inputting operator instructions. However, the device may be structured so that a manual input can be carried out with a predetermined pen (col. 5, lines 21-24). As shown in figure 4, area 1 displays the intensity of the electric field and the residual amount of the battery. For executing the general function of the device, LCD controller 14b drives the Y-driver 18d and the X-driver 18e to display information on the area 2. As an example, the LCD controller causes the drivers to display a telephone book on the area 2 (col. 5, lines 59-64). Closing LCD cover 30, when there is no need to display information in area 2, only area 1 continues to display information, and the display in area 2 is stopped (col. 6, lines 31-35). In addition, Nomura discloses that "the display drive of the area 2 may be changed through the LCD controllers 14 by the programs executed by not [sic] the mechanical switch but the CPU 10" (col. 7, lines 18-21).

From the disclosure of Nomura that the invention is directed to a radio communication device that transmits to a base station and displays signal and battery strength information on one logical portion of the display, and displays a telephone book on the second logical portion of the display, we find that the information device of Nomura discloses more than just a radio communication device. From the disclosure of Nomura that key set 31 may be replaced with a pen for inputting information and that

the device includes a CPU, controllers, memories and displays, we find that to input instructions from the pen and processing the input in a format that is used to display information will necessarily include some sort of computation, making the device of Nomura a computational module.

We are in agreement with the examiner (answer, page 12) that Nomura's disclosure of a CPU (in addition to the VRAM, ROM and controllers for displaying information) is a broad disclosure of a computer. We additionally agree with the examiner that the disclosure of displaying an address book is a disclosure of a personal organization feature. Moreover, from Nomura's disclosure of an antenna, radio communications transmitted to a base station and PHS functioning portion 28, we find disclosure of a communications device. From these disclosures of Nomura, we agree with the examiner that Nomura discloses a PDA. In addition, in the embodiment of figures 8-13, Nomura discloses "a small-sized portable computer having a size and a weight enough to be mounted on the palm of the operator's hand" (col. 8, lines 14-17). From this disclosure of a computer, we find that this embodiment of Nomura is directed to a PDA. However, although figure 9 appears to disclose a microphone and speaker, the block diagram of figure 8 does not disclose this embodiment to have a radio communications device that operates through a base station. While figures 1 and 7 disclose PHS functioning portions, this is

not present in figures 8-13. We also note that this embodiment does not include a signal strength meter in the display, or an antenna. Accordingly, we do not rely upon this embodiment as this embodiment does not appear to include a phone. We decline to speculate as to whether a phone is included but not displayed in this embodiment. We add that in figure 8, although there is no reference to a PHS functioning portion, there is a box labeled "other elements." However, the specification (col. 8, lines 21 and 22) appears to refer to the other elements as a system memory.

We are not persuaded by appellant's assertion (brief, page 7) that Nomura does not anticipate claim 1 because Nomura does not teach both a PDA and a cellular communicator. As we found, supra, Nomura teaches the use of a PDA from Nomura's disclosure of the information device to have a CPU, controllers, memory, radio frequency communicator, an address book, which is a personal organizer, and a pen input.

We agree with appellant (brief, page 8) that Nomura does not contain an express teaching of a PDA. However, from the disclosure of Nomura, we find that Nomura's information device inherently includes a PDA.

Nor are we persuaded by appellant's assertion (id.) that Nomura cannot inherently teach a PDA and a cellular communications device because figure 4 of Nomura does not include

any mention of a PDA, but rather shows a signal strength area and a phone book area. To establish that Nomura inherently discloses a PDA, it is not necessary that there is an explicit disclosure of the terms "personal digital assistant." What is required is that from the disclosure of Nomura an artisan would be taught that the information device includes a PDA in addition to a cellular communicator. From the disclosure of a telephone book that is displayed, along with the disclosure of a CPU, controllers, memories, and a pen input, we agree with the examiner that the information device is a PDA. However, even if we are wrong, and the disclosure of a CPU, controllers, memory, address book and pen input device are not sufficient to establish that the information device includes a PDA, we note the disclosure of Nomura (col. 3, lines 1 and 2) that figure 4 is a view showing one example of information displayed (underlining added). We find this to be a teaching to an artisan that the telephone book is not the only item to be displayed, and that other information can be displayed. In addition, appellant has not provided any definition of a PDA that would preclude a telephone book display from being considered to be a display of a PDA. If a PDA did not include a telephone book, certainly the assignee, Intel Corp., would be in a position to provide information that a PDA does not include an address book, which appellant has not done.

Nor are we persuaded by appellant's assertion (brief, page 9) that both display areas display information relating to a personal phone. We are cognizant that cell phones are notorious for containing address books. However, the fact that an address book relates to a cellular phone, does not preclude an address book from also relating to a PDA. We find no argument in the brief that would indicate that a PDA does not include an address book.

Nor are we persuaded by appellant's assertion (brief, page 10) that Nomura does not teach a multi-functional device that includes at least a PDA and a cellular communications device. Because Nomura discloses display of an address book as "one example of information displayed" we find that the display is not limited to an address book and is a PDA.

From all of the above, we are not convinced of any error on the part of the examiner, and find that Nomura anticipates claim 1. The decision of the examiner to reject claim 1, under 35 U.S.C. § 102(e) is therefore affirmed.

With regard to independent claims 5, 7, 12 and 19, appellant merely asserts that these claims recite that a portion of the display is used to display information associated with a PDA or computing module. At the outset, we note that merely pointing out limitations of a claim is not an argument for patentability of a claim. Nevertheless, as we found, supra, with respect to

claim 1, Nomura discloses a PDA. In addition, as discussed, supra, the use of a pen input will require some kind of computation. Accordingly, the rejection of independent claims 5, 7, 12 and 19 is affirmed, along with claims 8, 9, 13-18, 20-22, dependent therefrom. In addition, as claims 24-27 have not been argued by appellant, they fall with claim 1. Accordingly, the rejection of claims 20-24 under 35 U.S.C. § 102(e) is affirmed.

With regard to independent claim 28, appellant asserts (brief, page 10) that claim 28 recites, inter alia, "displaying information relating to a wireless communications module on one portion of a display and displaying information on a second portion of the display related to a computing platform." As we stated, supra, mere listing of the limitations of a claim is not an argument for the patentability of the claim. Nevertheless, as we found, supra, with respect to claim 1, figure 1 shows a display of information in area 1 relating to signal strength, which we consider to be related to a wireless communication module. In area 2, a telephone book is displayed, which we consider to be related to a computing module because of the disclosure of the CPU, memories, controllers, and pen input. From all of the above, we are not convinced of any error on the part of the examiner in rejecting claim 28 under 35 U.S.C.

§ 102(e) as being anticipated by Nomura. Accordingly, the rejection of claim 28, and claims 29-32, dependent therefrom, is affirmed.

We turn next to the rejection of claims 2-4, 6, 10, 11 and 23 under 35 U.S.C. § 103(a) as being unpatentable over Nomura in view of Britz and Imai. Turning to claim 2, appellant asserts that Britz and Imai do not make up for the deficiencies of Nomura. However, in view of our findings, supra, with respect to the teachings of Nomura, and the lack of any substantive arguments by appellant, we will sustain the rejection of claims 2-4, 6, 10, 11 and 23 for the reasons set forth by the examiner in the answer (pages 9-11). Accordingly, the rejection of claims 2-4, 6, 10, 11 and 23 under 35 U.S.C. § 103(a) is affirmed.

OBSERVATIONS AND REMARKS

We observe that this application is a reissue of U.S. Patent No. 5,841,431. 37 CFR § 1.173 sets forth that "[t]he entire specification, including the claims, of the patent for which the reissue is requested must be furnished in the form of a copy of the printed patent, in double column format, each page on only one side of a single sheet of paper." From our review of the application file, it does not appear that the specification has been presented in accordance with 37 CFR § 1.173.

37 CFR § 1.172 sets forth that the reissue oath must be accompanied by the written consent of all assignees. The consent of the assignee must be signed by a party authorized to act on behalf of the assignee (MPEP² 1410.01). From our review of the file, we find no written consent by the assignee in the file. In addition, the examiner should review the file to see if there was any attempt to recapture cancelled subject matter. The examiner is advised that the three step test for recapture is set forth in MPEP 1412.02. 37 CFR § 1.173 also sets forth that matter added by reissue must be underlined. The patent subject to the instant reissue contains 11 claims. Claims 12-32 were added in a pre amendment. 37 CFR § 1.173(b)(2)(B) requires that "[f]or each new claim added to the reissue by the amendment being submitted . . . the entire text of the added claim must be presented completely underlined." From our review of the application, it does not appear that the added claims 12-32 have been underlined; see MPEP 1453. MPEP section 1454, entitled "APPEAL BRIEF" sets forth that in the appeal brief, any new claims added in the reissue application should be completely underlined. From our review of the appendix to the brief, we find that claims 12-32 are not underlined. However, as we are primarily a Board of review, we

² Revision 2, Eighth Edition, published May 2004.

leave these matters to be addressed by the examiner subsequent to the appeal.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 5, 7-9, 12-22 and 24-32 under 35 U.S.C. § 102(e) is affirmed. The decision of the examiner to reject claims 2-4, 6, 10, 11 and 23(a) under 35 U.S.C. § 103(a) is affirmed. Thus, we have affirmed all of the rejections of the examiner.

AFFIRMED

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Appeal No. 2005-0130
Application No. 09/721,790

Page 18

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